



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,571	08/29/2005	Eric Appelman	118989-05010505	8780
20583	7590	12/07/2009	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017				MCCULLLEY, MEGAN CASSANDRA
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Response to Arguments***

The amendments to the claims will not be entered because the scope of the claims is changed; new issues are raised which would require a further search and/or consideration. For example, in claim 20 the scope is changed from the polyester consisting essentially of to the polyol component consisting of. However, while the amendments in claims 1 and 2 change the scope of the claims by broadening the definition of the impact modifier to include a polyester as an alternative, if these amendments were submitted separately without the change in claim 20, they would be entered. If this were the case, the prior art rejection set forth in the final Office action would remain since the prior art teaches at least one of the alternatives for the impact modifier.

While arguments to the not entered amendments will not be addressed below, applicant's arguments pertaining to the finally rejected claims will be discussed for further clarification.

Applicant's arguments filed November 17, 2009 have been fully considered but they are not persuasive.

A) The examiner wishes to thank the applicants for clarifying the typographical error in the final Office action. In fact, claim 2 should have been listed instead of claim 6 in the 35 USC 112, second paragraph rejection as pointed out in the applicant's remarks.

B) Applicant's argument that Mulhaupt does not teach the polyester impact modifiers of the pending claims with sufficient specificity is not persuasive. Mulhaupt

requires a polyester component of formulae I-IV (col. 2 lines 40-67). The polyesters must be composed of 70% dimeric or trimeric fatty acid (col. 3 lines 1-10). The polyesters can have up to 30% of another diol falling within the instant claim limitations (col. 6 lines 49-56). This analysis is arrived at directly from the teachings of Mulhaupt and without the guidance of the instant application.

C) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

D) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan McCulley whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Thursday 7:30-6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/M. M./  
Examiner, Art Unit 1796